

REMARKS

Claims 139-156 are pending in the present application. The Applicants, in an attempt to expedite the prosecution, cancel claims 128 and 131-134 without prejudice to their presentation in a continuing patent application.

Claims 145, 149, and 153 have been amended to even more clearly describe Applicants' inventions. Although the Advisory Action suggests that the recitation of C₂₋₁₂ 1-alkynyl groups in these claims as one selection for variable R² lacks support in the specification, Applicants note that support is provided at, for example, page 17, lines 5-6, which states that R² can be an 1-alkenyl or 1-alkynyl group having two to twelve carbon atoms.

Claims 139-156 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent 5,645,985 ("the Froehler patent"). The stated basis for maintaining this rejection is that the PTO had not yet granted Applicants' petition for priority from an earlier-filed patent application. That petition, however, has since been granted, and a copy is enclosed herewith.

Accordingly, Applicants respectfully request that that the rejection for alleged anticipation in view of the Froehler patent be withdrawn.

Applicants respectfully thank the Examiner for withdrawing his rejection of claims 139-144 in view of the Haralambidis reference.

Applicants request clarification, however, with respect to the Examiner's assertion that the Haralambidis reference "teaches the compound of claims 145-156" (Advisory Action at page 2). Claims 145-156, for example, are not limited to a single compound, nor have they been alleged to be anticipated by the Haralambidis reference. The only outstanding rejection of these claims in view of the Haralambidis reference is for alleged obviousness and, as Applicants noted in prior correspondence, even this rejection is improper because there is no evidence of record suggesting that the Haralambidis reference or any other cited reference would have led those of ordinary skill to any claimed invention. Indeed, it is undisputed that the structures disclosed in the Haralambidis reference and the Gelfand patent differ from those recited in claims 145-156, and the Examiner has yet to provide any reason that those of

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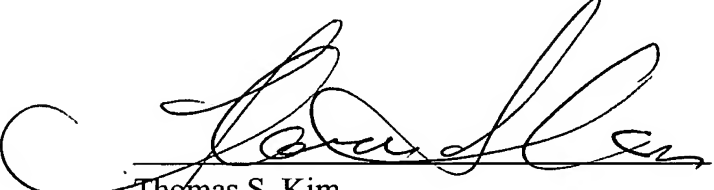
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PROCEDURE PURSUANT TO
37 CFR § 1.116**

ordinary skill would have had for modifying the disclosed structures in a way that would have produced a claimed invention.

CONCLUSION

In light of the foregoing amendments and remarks, the Applicants respectfully submit that all pending claims are in condition for allowance and solicit an early indication to that effect. The Examiner is invited to contact the undersigned to discuss any remaining concerns and to expedite allowance of the application.

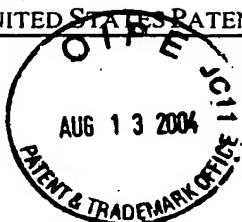
Date: August 13, 2004


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JUL 14 2004

In re Application of
Brian Froehler et al
Application No. 10/024,818
Filed: December 18, 2001
Attorney Docket No. GLIS-0143

: OFFICE OF PETITIONS
:
: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
:

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed June 7, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

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¹ Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

COPY SENT TO CLIENT

ON 7/23/04



Application No. 10/024,818

-2 -

The instant pending application was filed on December 18, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional applications has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional applications was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. See 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

The examiner of Technology Center Art Unit 1637 will consider applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt